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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			CHAMPAGNE, DONALD	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09659664

Filing Date: 7 May 2003

Appellant(s): ADAM D. SOUTHAM et al.

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Timothy D. Clise, Esq., For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 22 March 2006 appealing from the Office action mailed 15 July 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Logan et al., US005721827A, 24 February 1998

Ginter et al., US005892900A, 6 April 1999

"Internet Distributors signs international syndication agreement with IEE Network", PR Newswire, p0121LAW064, 21 January 1998.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims. This is a verbatim copy of the final rejection mailed on 15 July 2005.

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2 May 2005 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 1-3 and 6-60<sup>1</sup> are rejected under 35 U.S.C. 103(a) as being obvious over Logan et al. (US005721827A) in view of Ginter et al. (US005892900A) and further in view of Internet Distributors (NPL).
4. Logan et al. teaches (independent claims 1, 30, 51 and 56) a system and method for exposing users to advertisements, the method comprising: obtaining a user specific set of data, *user data 143*, prior to distributing a media package (col. 5 lines 9-19); selecting a number of advertisements from a data bank *135* containing a plurality of advertisements based on the user specific set of data (col. 4 lines 15-27, col. 24 line 1 to col. 25 line 31, and col. 9 lines 41-57); and combining the selected number of

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<sup>1</sup> As appellant notes, this summary is a typo: the rejected claims are in fact 1, 2 and 5-60.

advertisements with a requested set of media content to form a media package (*download compilation file 145*), and distributing the media package (col. 5 lines 19-36 and col. 15 lines 35-41).

5. Logan et al. does not teach maintaining a database of distribution restrictions. Ginter et al. teaches maintaining a database **610** of control and usage related information (col. 12 lines 11-12, col. 63 lines 36-39 and Fig. 7), which reads on distribution restrictions. Because Ginter et al. teaches a comprehensive system for distributing electronic information while protecting rights (col. 2 lines 19-32 and col. 3 lines 18-22), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add maintaining a database of agreements to the teachings of Logan et al.
6. Neither reference teaches that the distribution restrictions are of syndication broadcast agreements. Internet Distributors teaches distributing syndicated television programming via the Internet, which inherently requires the consideration of distribution restrictions of said television-programming syndication broadcast agreements. Because syndication broadcast agreements are a common programming limitation, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add Internet Distributors to the teachings of Logan et al. and Ginter et al.
7. Logan et al. also teaches (independent claims 9 and 39) an Internet user (col. 1 line 52) and localized data with geographically appropriate advertisements based on the obtained localized data (col. 9 lines 27-29), which, when inherently applied to the Internet, reads on with an appropriate geographic group of advertisements.
8. Logan et al. also teaches (independent claims 19 and 45) that the requested set of media content includes media content which has been previously distributed (col. 13 lines 45-55).
9. Logan et al. also teaches at the citations given above claims 2, 14, 31-34, 37, 52-55 and 57-60. Logan et al. also teaches claims 7 (col. 13 lines 3-20), 8 (col. 10 lines 3-4), 12 (col. 6 lines 48-51, col. 25 lines 4-14), 13, 17-18 and 40 (col. 25 lines 26-31 and col. 9 lines 41-57), 21 (col. 8 line 66), 24 and 43 (col. 14 lines 43-44), 35 (col. 29 lines 63 to col. 30 line 7) and 36 (col. 6 lines 48-51).

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10. Internet Distributors teaches (independent claims 25, 47 and 48, and dependent claims 5, 15-16, 23, 26, 28, 42, 46 and 49) syndicated television programming, which inherently reads on a network including a regional broadcast station and syndicated media content.
11. Claims 22, 27, 41 and 50 are taught inherently. All ads must be either regional or national.
12. None of the references teach (claim 6) displaying ads as frames. Because this is the most common means for displaying ads on the Internet, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the display of ads as frames to the teachings of the references cited above.
13. None of the references teach (claims 10, 29 and 44) a global positioning system. Logan et al does teach a mobile receiver (col. 6 lines 18-32). Because GPS permits more precise geographic targeting of ads and provides the user with other benefits, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add GPS to the teachings of the references cited above.
14. None of the references teach (claims 11, 20 and 38) acquiring user data from an ISP or driver's license databases. Because both are readily available sources of good user characterization data, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the acquisition of user data from an ISP or driver's license databases to the teachings of the references cited above.

#### (10) Response to Argument

Before addressing appellant's arguments, it is helpful to summarize the rejection of independent claims 1, 30, 51 and 56 (para. 4-6 above):

- Logan et al. teaches every feature of these claims except a database of distribution restrictions.
- Ginter et al. teaches a database of distribution restrictions. Because said database enables the protection of property rights, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Ginter et al. to those of Logan et al.

- However, neither reference teaches that said distribution restrictions are syndication broadcast agreements. Internet Distributors teaches distribution restrictions that are syndication broadcast agreements. Because syndication broadcast agreements are a common means for protecting property rights, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Internet Distributors to those of the other two references.

The logic is straightforward. To traverse it, appellant offers three, similar, arguments, respectively in sections “a”, “b” and “c” on pages 11-17. First (p. 11, center), appellant argues that the combination of references fails to teach or suggest all of the claimed elements. In particular (pp. 11-12):

“Appellant respectfully submits that the syndication agreement of Internet Distributors does not allow for a selection of advertisements based in part on the syndicated media content distribution restrictions. **The syndication agreements of Internet Distributors are agreements solely for broadcasting on the Internet.**” (Emphasis added)

First, the claims are limited to distribution solely on the Internet. Distribution through any other media is not claimed. Second, Internet Distributors teaches (emphasis added):

“Television stations and cable operators acquire the right to air shows through syndication relationships with television distributors. **Internet Distributors establishes these same types of relationships** with the various television show producers and syndicators for airing on the Internet.” (Internet Distributors p. 2/3, 3<sup>rd</sup> para.)

There is no teaching or suggestion in the reference that the Internet syndication agreements are in any way incompatible with any cable and television syndication agreements. Indeed, the reference teaches that the Internet syndication agreements are entered with “the various television show producers and syndicators”. These producers and syndicators would not want to enter Internet agreements that were incompatible with their own television and cable agreements.

Appellant also argues (pp. 12-13) that the teachings of Logan et al. do not consider “distribution restrictions”. That is acknowledged by the rejection (para. 5). It is also bad logic: “One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references” (MPEP § 2145.IV).

Appellant's second argument ("b" beginning on the bottom of p. 13) is materially the same as the first argument. In the first full para. on p. 14, appellant argues (emphasis added):

**"The syndication agreement of Internet Distributors is directed solely toward Internet syndication and not conventional syndicated broadcast agreements as in the context of the claims.** Appellant respectfully submits that the syndication agreement of Internet Distributors would make the systems and methods of the present claims inoperable, and thus, fails to provide one of skill in the art a reasonable expectation of success."

First, the claims are not limited to "conventional syndicated broadcast agreements". Said agreements are mentioned in the preamble of some claims (e.g., claim 1), but that does not constitute a limitation. Second, the syndication agreements of Internet Distributors are not directed solely toward Internet syndication. The reference expressly teaches "the same type of relationships" for broadcast, cable and Internet syndication. There is nothing taught or suggested by any of the three references which would make the combination "inoperable".

Appellant goes on to argue (middle para. on p. 14), "For example, one contribution of the present application is the ability to preserve conventional broadcast agreements while distributing media packages over the Internet." First, the claims are not limited to preserving conventional broadcast agreements. Second, the preservation of conventional broadcast agreements while distributing media packages over the Internet is implicit in Internet Distributors. Internet Distributors teaches that the Internet syndication agreements are entered into with "the various television show producers and syndicators". These producers and syndicators would not want to enter into Internet agreements that violated their own conventional broadcast agreements.

Appellant's third argument ("c" beginning on p. 15) is materially the same as the first and second argument, but cloaked as "impermissible hindsight". The logic for combining the references is straightforward and presented twice above. The Board can readily judge if it is merely a hindsight construction.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Donald L. Champagne  
Primary Examiner  
Art Unit 3622

DONALD L. CHAMPAGNE  
PRIMARY EXAMINER

7 June 2006

Conferees:

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